

REMARKS

On behalf of the applicants, Mr. Thomas P McGarry and attorney Deshmukh take this opportunity to sincerely thank Examiner Graysay for graciously agreeing to conduct the interview on December 6, 2005. All the outstanding rejections were reviewed. A path forward was reached for overcoming the drawing objection. No agreement with respect to the pending claims was reached.

Applicants hereby acknowledge and confirm the restriction and election of claims 1-10, 34-37 and 46-48 made by applicants' attorney Deshmukh on July 19, 2005 in a telephone call with Examiner Graysay. The election was made without traverse. As a result, non-elected claims have been withdrawn from this application without prejudice of any sort to continue prosecution of that subject matter in this or any other application claiming priority herefrom.

Applicants hereby acknowledge and confirm the election of species VII directed the Paint Department Optimizer in claim 5 made by applicants' attorney Deshmukh on July 19, 2005 in a telephone call with Examiner Graysay. The election was made without traverse. It should be noted that claims 1-10 and 46-48 as well as the newly added claim 49 are generic to the elected species VII directed the Paint Department Optimizer and claims 34-37 are explicitly directed to the elected species.


The Applicants, therefore, agree to the withdrawal pursuant to 37 C.F.R. §1.142(b) of claims 11-33 and 38-45 that do not read upon the elected species, subject to rejoinder upon allowance of one or more of the generic claims (M.P.E.P. 809.02(c)).

Claims 5, 34-37 and 46-48 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

To overcome the forgoing rejection, claims 5 and 34 were amended by deleting the reference to the service mark "SM" in said claim. In claim 46, "client" survey on lines 4 and 6 has been deleted and substituted with - - customer - - survey. Support can be found on page 44, line 27 of the specification. In view of the foregoing amendments, claims at issue including the dependent claims depending therefrom have now overcome said rejection.

The drawings were objected to under 37 CFR § 1.83 (a). The Office Action stated that a drawing showing the features of the process steps directed to processing customer business data used for generating a business profile recited in claim 46 and on page 44 of the specification is required. A new Figure 18 based on the sketch shown to Examiner Graysay during the interview is attached for the Examiner's kind consideration. Appropriate changes to the specification on page 44 of the specification were also made to reflect the inclusion of the foregoing drawing. As a result, it is respectfully requested that the objection should be withdrawn.

The specification was objected to for not referring to numeral in red color in Figure 6CA and 6CB. The drawings were amended under 37 C.F.R. § 1.84 (n) by utilizing the symbols shown on page 606.110 in M.P.E.P. (Rev. 3

issued on August 2005). The symbol for "red" ( "vertical lines") was used to correct Figure 6CA. No correction was required in Figure 6CB.

The Office Action stated that Appendix A referenced on page 5, line 27 had not been received by the United States Patent and Trademark Office (USPTO). It is submitted that said Appendix A containing the source code was submitted by the applicants. The following receipt acknowledged by the USPTO is submitted to indicate that said Appendix A had been submitted by the applicants along with the specification.

The Stamp of the Patent Office hereon acknowledges the receipt, on the date indicated, of the following:

Case No.: EA0952 US NA Application No.: _____

Inventor(s): Goldschneider et al.

Title: Network-Based Business Process for Improving Performance of Businesses

☒ Application ☒ ADS ☐ Request for Extension of Time

Pages of Spec: 59 (incl. Abstract & Claims) ☐ Amendment ☐ Preliminary

Pages of Claims: 13 Response to: ☐ Office Action

☒ Utility ☐ CIP ☐ RCE/CPA ☐ Div. ☐ Notice to File Missing Parts

☐ Provisional ☐ Provisional Coversheet ☐ Issue Fee

☐ Declaration ☐ Power of Attorney ☒ Other Appendix A (226 Sheets) +

☐ Assignment ☒ Request and Certificate under 35 U.S.C. 112 (b)(2)(B)(i)

☒ Drawings 243 sheets ☒ Formal ☒ Fee Transmittal Sheet

☐ IDS ☐ Supplemental ☐ COM ☒ Express ET284674605US


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11017 U.S. PTO
09/887414
06/22/01

NOTED

During the course of reviewing the various documents filed, an error on the utility patent transmittal form was noted. Due to a typographical error, the utility patent transmittal form erroneously noted that 243 sheets of formal drawings accompanied the specification. For the record, only 143 sheets of formal drawings were submitted by the applicants, a fact duly noted on the filing receipt mailed by the USPTO on October 3, 2001, a relevant portion which is shown below. The foregoing error is sincerely regretted. A corrected utility patent transmittal form now accompanies this response.

Page 1 of 3

									
UNITED STATES PATENT AND TRADEMARK OFFICE									
COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE WASHINGTON, D.C. 20530 WWW.USPTO.GOV									
APPLICATION NUMBER	FILING DATE	GRP ART UNIT	PL FEE REC'D	ATTY DOCKET NO.	DRAWINGS	TOT CLAIMS	IND CLAIMS		
09/887,414	06/22/2001	2163	1862	FA0952 US NA	143	48	1		

23906 *S6D*
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WILMINGTON, DE 19898

CONFIRMATION NO. 8944

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AUG 15 2001

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FILING RECEIPT
F I L E D U S T O P A T E N T A N D T R A D E M A R K O F F I C E W A S H I N G T O N D C 20530
"OC0000000C8418762"

Date Mailed: 08/13/2001

The specification was also amended to include a reference to US provisional application from which the current application claims priority and to correct minor typographical errors.

No new matter has been added.

The Office Action rejected claims 1, 3, 4, 6-9, 10/1, 10/3, 10/4, 10/6, 10/7, 10/8 and 10/9 under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,556,974 to D'Alessandro (hereafter the '974 patent). The foregoing rejection and remarks associated therewith are respectfully traversed in view of the following remarks:

The '974 patent discloses a method for evaluating under the Malcolm-Baldrige National Quality Award criteria, the business performance based on a very subjective input from internal and external survey participants, such as, for example, on the effective leadership provided by the senior leaders to the employees taking the survey (Figure 3). The strengths or weaknesses on the performance of the senior leadership are then identified based on the input

received electronically from the survey participants. No such process is currently claimed nor will it occur to one of ordinary skill in the art to arrive at the currently claimed invention in view of the teachings '974 patent. The current process is diametrically opposite of the process taught in the '974 patent. The process in the '974 patent solicits the survey respondents to opine on how the business is doing based on the Malcolm-Baldrige National Quality Award criteria. By contrast, the current process provides objective business solutions to the customers by analyzing the business data entered in the customer computer.

It is alleged that the process of the '974 patent is capable of "requesting" a customer to choose a business tool insofar as the survey respondent that logs in chooses to respond to the survey (page 8, lines 1-3 of the Office Action). The foregoing statement is respectfully traversed. The log on procedure in the '974 patent is not the same is "requesting a customer to choose a tool from a menu" recited in the current step (b). The log-on procedure in the current step (b) **ONLY** allows access to the main menu. The customer **must** then "**choose**" one or more business tools from the main menu. Such as a step is neither disclosed nor even hinted in the '975 patent. Moreover, as noted at column 7, lines 7-10 in the '974 patent, the survey respondent **must answer each survey question**. There is NO choice. It is absolutely essential in the '974 patent for the respondent to answer each question for getting an accurate and meaningful survey on how good the leadership is performing. If the respondent opts to answer only few questions and not all of the questions, the resulting survey would be skewed and will not be meaningful. By contrast, the customer in step (d) can choose one or more business tool **by choice**. Thus, the process of the '974 teaches way from the current process and one skilled in the art would not look to the process disclosed in the '974 to arrive at the process claimed in the present invention.

The '974 patent only provides for taking a survey based on the Malcolm-Baldrige National Quality Award criteria as shown in Figure 5. None of the business tools recited in claim 5 are either taught or suggested in the '974 patent.

The Office Action takes Official notice of the log on procedure recited in claims 3 and 4. However, there is no teaching or suggestion in the cited art of

combinations of the steps claimed in claims 3 and 4, as depending from claim 1. Moreover, even if one were to combine the teachings known in the art with the teachings of the '974 patent in view of the comments made above. Thus, it is not seen why claims 3 and 4 are obvious.

The Office Action takes Official notice that the use of instructions as claimed in 6, 7, 10/6 and 10/7 were well known in the operations research field and in particular the field of online applications. There is no suggestions or such teachings in the '974 patent of such instructional steps. Thus, absent any such suggestions, it is not seen why one of ordinary skill in art would arrive at the claimed invention.

The applicants respectfully question the foregoing Official notice. It is respectfully submitted that at the time the invention in the current application was constructively reduced to practice, such instructions, for example (Paint Department Optimizer), shown on page 33, lines 6-15 of the specification were not known. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 165 USPQ 418, 420 (CCPA 1970). When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR § 1.104(d)(2).

It is not seen how one of ordinary skill in the art would have been aware of developing the instructions for using the business tools, which are novel and non-obvious. A mere disclosure of the use of internet in the '974 patent would not give rise to the presently claimed instructional tools. Thus, absent any such suggestion in the online applications, as alleged in the Office Action, it is not seen why one of ordinary skill in the art would arrive at claims 6, 7, 10/6 and 10/7. Moreover, in determining the differences between the prior art and the claims, the question under obviousness is not whether the differences **themselves** would have been obvious, but whether the claimed invention **as a whole** would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 218 USPQ 698 (Fed. Cir. 1983). The Office Action failed to provide such a

determination, absent which, it is not seen why the claimed invention would be obvious.

The Office Action noted that claims 8 and 10/8 are obvious since the '974 patent inherently includes a validation step whereby analysis is performed after all users have completed the survey (emphasis added in the Office Action). Applicants respectfully traverse the foregoing rejection, since what is claimed is not inherent from the teaching in the '974 patent. The '974 patent at column 7, lines 44-53 states "[W]hen **all questions are completed** and a "save last answer question" button is selected, the survey is flagged as done 260 for final database 100 entry. Analysis 140 is available when **all users complete their survey**. Data from this part of the survey helps the organization evaluate the current level of organizational consistency about perceptions of effectiveness and efficiency between and among different levels of staff, across all operations, between staff members, and between and among the pool of external respondents as well, if any." (emphasis added). By contrast, in the present invention the user has a **choice** of selecting **one or more** business tools, i.e., there is no requirement of selecting ALL of the business tools nor is there a requirement of ALL users using ALL of the business tools. Each user has a choice of selecting one or more business tools and of utilizing as much portion of the business tools as needed. See also Figure 3C, item 137 in the present specification. The cited prior art provides the user NO choice. By contrast the current process provides user ample choices. Even the Office Action expressly admits the presence of such a requirement. Thus, the '974 patent appears to teach away from the current invention.

The Office Action in rejecting claims 9 and 10/9 under 35 U.S.C. §103 (a) takes Official notice that the use of on line help was old and well known in the computer art. The applicants respectfully question the foregoing rejection. It is not seen how one of ordinary skill in the art would have been aware of developing the on line instructions for using the business tools, which are novel and non-obvious. A mere disclosure of the use of internet in the '974 patent would not give rise to the presently claimed instructional tools. Thus, absent any such suggestion in the online applications, as alleged in the Office

Action, it is not seen why one of ordinary skill in the art would arrive at claims 9 and 10/9.

The rejection of claims 2 and 10/2 under 35 U.S.C. §103 (a) as being unpatentable over the '974 patent as applied to claim 1 and then further in view of US Patent 5,757,917 to Rose (hereafter the '917 patent) is respectfully traversed. It is submitted that since claim 1, in view of the foregoing remarks, is non-obvious over the '974 patent, it would not occur to one of ordinary skill in the art to combine the teachings in the '974 patent with those in the '917 patent. Thus, all the claims depending therefrom are also non-obvious.

Moreover, there is no such suggestion or teaching in either of these references that would lead one of ordinary skill in the art to combine these two references absent any suggestion or teaching therein. As noted repeatedly in the '974 patent that it is directed to conducting employee survey whereby **ALL** the employees must respond to get any meaningful data. Thus, it is incongruous and illogical to expect the **employees to pay for taking such surveys** in order to inform the management how good or bad the management is performing (See fig. 5 of the '974 patent). Since, the survey, based on the Malcolm-Baldrige National Quality Award criteria, is quite subjective, it would not behoove the surveyor to make the survey participant to pay for taking such a survey and then expect participants to provide truthful answers. Thus, it is not seen why one of ordinary skill in the art to combine the teachings in the '974 patent with the '917 patent since such a combination will defeat the very purpose for which it is used.

The rejection of claims 5, 10/5 and 34-37 under 35 U.S.C. §103 (a) as being unpatentable over the '974 patent as applied to claim 1 and then further in view of US Application US 2003/0171981 to Bargnes et al. (hereafter the '981 application) is respectfully traversed. It is submitted that since claim 1, in view of the foregoing remarks, is non-obvious over the '974 patent, it would not occur to one of ordinary skill in the art to combine the teachings in the '974 patent with those in the '981 application. Thus, all the claims depending therefrom are also non-obvious.

Moreover, there is no suggestion or teaching in either of these references that would lead one of ordinary skill in the art to combine these two references absent any suggestion or teaching therein. Unlike the current

invention, as noted in steps 31 and 32 of Figure 2, and page 6, lines 8-11 of the current specification, there is no dedicated algorithmic module of a chosen business tool used to carry out a business analysis of the chosen business tool either in the 974 patent or in the '981 application; nor is there any suggestion or teaching in either of these references to arrive at the presently claimed invention. Moreover, as noted in Figure 2 in the '981 application, the process therein utilizes a single business module 60 (also page 2, paragraph 30 of the '981 application) to conduct seven business applications, such as "Customer Financial Data, Forms & policies-Business Plan-Operating Manual, etc. which then interacts with a single transaction module 64. As noted in paragraph 30 on page 2 of the '981 application, user must input customer financial data 80, customer, facility and personnel information 84, customer assessment of priorities 88, and production shift information 89 in order for business analysis module 60 to identify best practices 92, analytical worksheets 96, and forms and policies of the business 100 in business module 60 to get specified outputs. See also Figure 2 of the '981 application. No such architecture is utilized nor is it desired in the current invention. One of ordinary skill in the art would appreciate that a complex single business/transaction module would be far more difficult to revise or upgrade than series of distinct dedicated modules, which can be independently revised or upgraded without affecting the whole software architecture. In addition, the user in the current invention is not required to enter a substantial amount of data to get the output that may not require such voluminous data entry. As a result, the process of present invention is substantially less cumbersome than the process disclosed in the '981 application. As noted above, the current invention utilizes an entirely novel arrangement whereby each business tool recited in claim 5 has independent input/output architecture contained within its own algorithmic module. As a result, the user is provided with a substantial flexibility to tailor his or her business priorities and interests. Such processes and software associated therewith were neither suggested nor would be possible in the cited art taken alone or in combination.

In rejecting claims 34-37, the Office Action noted that the particular computations or analyses related to evaluating optimization are within the levels of ordinary skill in the operations research art. The foregoing rejection

and the comment associated therewith are respectfully traversed. Applicants assert that the steps recited in these claims are non-obvious. As noted earlier, if Official notice is to be taken, then applicants wish to be provided with the prior art on the basis of which a determination was made that such steps are routine. Absent such a showing, it is submitted that claims 34-37 are non-obvious since no *prima facie* showing of obviousness has been made and the burden of making such a showing still rests with the Office.

Claims 46/1, 47/1 and 48/46/1 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over the '974 patent as applied to claim 1 and then further in view of White publication (How Computer Works). The foregoing rejection is traversed, since it is submitted that claim 1 in view of the foregoing remarks is non-obvious. Thus, all the claims depending therefrom are also non-obvious. Furthermore, there is no suggestion or teaching in the White publication that would motivate one of ordinary skill in the art to combine it with the '974 patent.

Claims 46/5, 47/46/5 and 48/46/5 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over the '974 patent and the '981 application as applied to claim 5 then further in view of White publication (How Computer Works). The foregoing rejection is traversed, since it is submitted that claim 5 in view of the foregoing remarks is non-obvious. Thus, all the claims depending therefrom are also non-obvious. Furthermore, there is no suggestion or teaching in the White publication that would motivate one of ordinary skill in the art to combine it with the '974 patent.

In order to further the prosecution, claim 1 was amended to further distinguish it over the '974 patent and the '981 application. To recite claim 1 with more particularity, in step (b) "businesses" has been deleted, substituted with "customer", step (c) is amended to recite "one of said" business tools from said menu and step (f) has been amended to recite "to identify process problems and poor financial performance of said customer". Support can be found on page 8, lines 1-13 and page 5, lines 11-13 of the specification.

There is no teaching in the '974 patent and the '981 application of providing a business solution that identifies process problems and poor financial performance of a customer. Moreover, there is no suggestion or teaching in the '981 application of utilizing steps (c), (d), (e) and (f) as recited

in claim 1 nor would these steps occur to one of ordinary skill in the art in view teachings in the '974 patent and the '981 application, taken alone or in combination.

Additional claims have been added for the Examiner's consideration. Support for claim 49 can be found on page 4, lines 22-24 and lines 33-34, and on page 5, lines 1-2 of the current specification. Support for claim 50 can be found on page 40, lines 22-23 and lines 17-19 of the current specification. Support for claim 51 can be found on chart at line 9 on page 40 of the current specification. Support for claim 52 can be found on page 40, line 19 of the current specification and in Figs 16BA1 through 16BP2. Support for claim 53 can be found in Fig 16B of the current specification. Support for claim 54 can be found in Fig 16C of the current specification. Support for claim 55 can be found on page 40, lines 25-28 and on page 41, lines 1-3 and 20-24 of the current specification. Support for claim 56 can be found on page 41, lines 5-8 of the current specification. Support for claim 57 can be found on page 41, lines 8-9 of the current specification. Support for claim 58 can be found on page 40, lines 20-22 of the current specification.

Should the Examiner wish to discuss any issues involved in this application, the Examiner is respectfully invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Dated: December 20, 2005

ATTACHMENTS - corrected utility patent transmittal form

- New Figure 18
- Amended Figure 6CA
- Petition to extend the time respond by two months